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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/319,071	07/07/1999	RITSKE CLEWITS	96.968US	2335

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EXAMINER

PATEL, JAGDISH

ART UNIT PAPER NUMBER

3624

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/319,071

Applicant(s)

CLEWITS, RITSKE

Examiner

JAGDISH N PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5, 10 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5, 10 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to amendment filed 9/8/2003.

Response to Amendment

2. Claims 5 and 10 have been amended.
3. The pending claims 2-5, 10 and 12 have been rejected on new ground of rejections and a new non-final action is issued.

Response to Arguments

4. Applicant's arguments regarding previously rejected claims 2-5, 10 and 12 under 35 U.S.C. 112, first paragraph are persuasive. Accordingly said rejection and corresponding objection to the specification has been withdrawn.
5. The pending claims have been further analyzed as in view of their applicability to 112(sixth) (means plus function) format.
6. However, the claims fail to meet the requirements set forth to invoke 112 (sixth paragraph) as explained below. Accordingly, the claims have been further examined by giving the limitations "broadest reasonable interpretation", i.e. as reading on any prior art means or step which performed the function specified in the claim without regard for whether the prior art means or step was equivalent to the corresponding structure or acts described in the specification. (see MPEP 2181 in particular

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see application of ruling of In Re Donalson). As stated in this section of the MPEP:

7. "A claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph if it meets the following 3-prong analysis:

(A) the claim limitations must use the phrase "means for " or "step for ";

(B) the "means for " or "step for " must be modified by functional language; and

(C) the phrase "means for " or "step for " must not be modified by sufficient structure, material or acts for achieving the specified function."

System claims 5, 10 and 2-4 and method claim 12 do not meet the three-prong test. As an example claim 5 recites limitations "reading means for receiving..information career.." and "programming means for modifying the numerical value ... programmable device". However, both claim limitations recited as "means for" (ex. "reading means for receiving..") are further modified at least by additional structural limitation "programmable device" in the "wherein.." clause. Claim 5, therefore does not meet the requirements outlined above for invoking 112 (sixth). (Refer to MPEP section 2181 for further details of 112(sixth) requirements). System claims 10 and 2-4 when similarly analyzed also rendered outside the meets of 112(sixth). Method claim 12 does not meet all three

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requirements. Therefore, all claims are not interpreted in accordance with 112, Sixth Paragraph and have been analyzed without regard to the structure or acts disclosed in the specification.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 5, 10, 2-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5, recites (a) that "programmable device is a timer" and (b) "A system for selective activation of ..functions in a programmable device, comprising: "reading means.. ",
"..programming means.." wherein the programmable device [timer] is coupled ..to the programming means..".

Since claim 5 recites the programmable device as a timer, it contradicts with the teaching of the specification which on p. 6 line 30 through p. 7 line 6 recites " ..The programmable device will usually will not comprise the programming means in this application, and the timer will have to be programmed in

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accordance with the end user's wishes." Claim 5 which recites a timer, is clearly, in contradiction to the teaching of the disclosure. The claim is therefore rendered unclear and indefinite. The claim is further analyzed such that the programming means is not included in the claim. The claim reads as follows: A system for selective activation of ..functions in a programmable device, comprising:

"reading means for receiving .. value stored therein.

[Note that claim so interpreted is rendered a single means claim where a means recitation does not appear in combination with another recited element of means is subject to an undue breadth rejection under 35 USC 112, first paragraph (see MPEP 2164.08(a)).]

Claim 10 recites "programming means for modifying ..numerical value.." and "in accordance with ..functions..being purchased and activated in the programming device". However, the claimed system fails to provide any link(s) (or coupling) among the programmable device, the reading means and the programming means". This deficiency renders the configuration of the system unclear and indefinite.

For examination purpose it is assumed that the reading means, the programming means and the programmable device are coupled electronically.

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Dependent claims 2-4 also inherit same weakness.

Note that this weakness is also present in claim 5. It also assumed that the reading means is coupled to the programmable device in claim 1.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 2-5, 10 and 12 rejected under 35 U.S.C. 102(e) or alternatively under 35 U.S.C. 102(b) as being anticipated by Tsunokawa et al. (US Patent 5,546,446) (hereafter Tsunokawa) (alternatively equivalent Japanese Publication 5-285563 which caused US Application 326,280, filed Oct 20, 1994, Foreign Priority Oct 21, 1993).

Claim 5: As per claim 5, Tsunokawa teaches a system for selective purchase and activation of one or several software and/or hardware functions in a programmable device comprising a reading means for receiving an electronically readable carrier

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that includes a programmable memory having a numerical value store therein (abstract ..each of the public telephone sets includes a reading unit for reading card information recorded in a prepaid card for ..).

Claim 10: Tsunokawa teaches a system for selective purchase and activation of one or several software and/or hardware functions in a programmable device in which the functions are unavailable for use until purchased and activated. Comprising:

reading means for receiving an electronically readable carrier that includes a programmable memory having a numerical value store therein (abstract ..each of the public telephone sets includes a reading unit for reading card information recorded in a prepaid card for ..; col. 1 L 14-18, L 19-22 "a call rate as valid information is read from the inserted card, and at the same time, a speech communication the readout call rate is allowed", the numerical value is call rate (e.g. amount still remaining) stored in the card as read by the reading means disposed in the telephone set (shown in Fig. 1, items 1₁, 1₂..etc. are programmable devices which contain the reading means explained in col. 2 L 46-56)

programming means for modifying said numerical value in accordance with the previously unavailable functions that have

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been made available for use by being purchased and activated in the programmable device (col. 1 L 25-28 "Upon completion .. a remaining call rate is recorded in the inserted card..", note that the numerical value (e.g. amount still remaining call rate amount) is modified in accordance with the telephone call function which is unavailable until purchased and activated in the telephone card).

[note both the reading means and the programming means are recited as per claim 10 in the remainder of the Tsunokawa reference. Please refer to col. 5 L 5-56, col. 6 L 30-55 etc. for further pertinent details of the programming means].

Claim 2: the programmable device comprises the programming means and the reading means (refer to claim 1 analysis).

Claim 3: the programmable device is an automatic payment machine (the programmable device of Tsunokawa is a public telephone set which facilitates automatic payment for telephone calls via the prepaid telephone card).

Claim 4: the programmable device is coupled ..to the programming means and the electronically readable information carrier (as per Tsunokawa the telephone set is coupled to the inserted card and the card validation system as discussed in col. 5 L 5-56, col. 6 L 30-55 etc. and Figures 4 and 5).

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Claim 12. Tsunokawa discloses a method of activating a function of a programmable device (public telephone set telephone set 1) having a plural functions (service calls) that are unavailable for use until being selectively purchased and activated, the method comprising the steps of:

Electronically reading an electronically readable information carrier on which a first value (col. 1 L 63- col. 2 L 8, ..refer to reading means for reading the card information recorded in the prepaid card..);

Coupling the programmable device having the plurality of functions that are unavailable for use ..to the program capable of selectively purchasing and activating the plural functions (the telephone set is coupled to the card validation system for card validation system for performing card management, refer to Figure 1 and col. 2 L 50-56);

Selecting at least the plural functions to be made available (col. 6 L 30-36, speech communication originating from the public telephone set, note that the user of the telephone set selects (originates) on or more speech communication calls);

Making available and activating the selected function ((col. 6 L 30-36, speech communication originating from the public telephone set, note that the user of the telephone set selects (originates) on or more speech communication calls);

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Coupling the program to the information carrier (the prepaid telephone card is coupled to the card validation system for card validation system for performing card management, see Figure 1, col. 2 L 46-56);

Purchasing the activated function by debiting from the first value a second value of the activated function (col. 30-36, Referring also to Figures 5 and 6, ..the call rate used for this speech communication is subtracted from the call rate read upon insertion of the card in step S132, and the remaining call rate is in the card in step S133).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) 305-7687. **Draft faxes may be submitted directly to the examiner at (703) 746-5563.**

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address

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for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7th
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